

## REMARKS

### Summary of Examiner's Action

In the subject office action, the Examiner rejected claims 1-2, 4-6, 10-12, 14-15, 17, 19-25, 26-30 and 40-41 under 35 USC 103 as being obvious in view of McBride et al (USP 5,923,752), and Barnes et al (US 4,292,481).

Claims 3, 7-9, 13, 16 and 18 were objected to for being dependent on rejected claims, otherwise allowable.

Claims 31-39 were found allowable over prior art.

### Summary of Applicants' Response

In response, Applicants amended claims 40-41, and respectfully traverse the Examiner's rejections against 1-2, 4-6, 10-12, 14-15, 17, 19-25, 26-30.

### Drawings

Applicants have chosen to replace Figures 11, 12, 13A and 13B to conform to Figures 1-10.

Rejections against claims 1-2, 4-6, 10-12, 14-15, 17, 19-25, 26-30 and 40-41 under 35 USC 103 in view of McBride and Barnes combined

### Claim 1

Claim 1 recites

a resilient semi-rigid shell including a front face and back face commonly connected to a side portion and having a substantially U-shaped profile adapted to wrap around a substantial portion of a front, back and side of the mobile communications device upon assembly over the mobile communications device (underline added).

In rejecting claim 1, the Examiner acknowledged that McBride merely teaches an outer cover having a front face commonly connected to side portions forming a U-shape profile, and failed to teach the required front face and back face commonly connected

to a side portion forming a U-shape profile. However, the Examiner reasoned that Barnes teaches a cover that has a front face and a back face commonly connected to a side portion for receiving a decorative appliqué. Therefore, it would have been obvious for one ordinarily skilled in the art to modify McBride in view of Barnes to arrive at the present invention.

Applicants respectfully disagree.

It is well settled that to assert obviousness based on a combination of references, either at least one of the references or the knowledge generally available to one of ordinary skilled in the art, includes teachings that would suggest and motivate the person to make the combination. See e.g. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Barnes' teachings are directed towards the application of a decoration appliqué to a telephone. Physically, a decorative appliqué is very different from a mobile phone. The former is basically a thin, light weight card with a substantially square form factor that has virtually no thickness. Compared to the decorative appliqué, a mobile phone is typically narrower, thicker, and heavier.

Neither reference contains any teachings that suggest to one ordinarily skilled in the art that the configuration teachings of a front cover to facilitate provision of a thin, light weight, substantially square, and virtually no thickness decorative appliqué, can be applicable to the configuration of a front cover to cover a mobile phone, that is thicker, heavier and narrower (when compared to the decoration appliqué), or vice versa.

The Examiner also has not provided any support that such knowledge of the interchangeability of design principles is in the possession of one of ordinary skill of the art.

Further, even if we are to ignore the above discussed physical differences between a decorative appliqué and a mobile phone, Barnes' side opening embodiment

is an alternate embodiment to a conventional faceplate embodiment (Fig. 1), a one piece flat transparent embodiment (Fig. 2), and a two part embodiment (Fig. 4).

Nowhere did Barnes' teach its side opening pocket embodiment may be an alternate embodiment to a bottom opening pocket embodiment.

Thus, Applicants submit, but for the impermissible application of hindsight and usage of Applicants' teachings, one ordinarily skilled in the art would not appreciate the configuration teachings of a front cover to facilitate provision of a thin, light weight, substantially square, and virtually no thickness decorative appliqué, can be applicable to the configuration of a front cover to cover a mobile phone, that is longer, thicker, heavier and narrower (when compared to the decoration appliqué), or vice versa.

Therefore, but for the impermissible application of hindsight and usage of Applicants' teachings, no one ordinarily skilled in the art would modify McBride in view of Barnes to arrive at the present invention.

Thus, withdrawal of the inappropriately based rejection against claim 1 is respectfully requested.

Claims 2, 4-6, 10-12, 14-15, 17, 19-25, 26-30

Claims 2, 4-6, 10-12, 14-15, 17, 19-25, 26-30 depend on claim 1, incorporating its limitation. Since for reasons discussed earlier, claim 1 is patentable over the cited references, for at least the same reasons, claims 2, 4-6, 10-12, 14-15, 17, 19-25, 26-30 are patentable over the cited references.

Claims 40 and 41

Claim 40 has now been amended to clearly require one of the surfaces of the interchangeable cover to have advertisement of an advertiser. In rejecting claim 40, the Examiner relied the McBride's teachings in col. 3, lines 29-36, where McBride teachings the inclusion of a "logo" on to cover. One ordinarily skilled in the art will understand the teaching to mean "identification" of the manufacturer of either the cover or the phone. No one ordinarily skilled in the art will read the passage as teaching the claimed method

of including advertisement with a cover, such that compensation may be recovered from the advertiser. Thus, amended claim 40 is patentable over the cited references.

Claim 41 depends on claim 40, incorporating its limitations. Thus, for at least the same reasons, claim 41 is patentable over the cited references.

Objections against claims 3, 7-9, 13, 16 and 18

Claims 3, 7-9, 13, 16 and 18 depend on claim 1 incorporating its limitations. Since for reasons discussed earlier, claim 1 is patentable over the cited references, for at least the same reasons, claims 3, 7-9, 13, 16 and 18 are patentable over the cited references, without having to be re-written in independent form incorporating the limitations of its base and intervening claims.

Claims 31-39

Claims 31-39 were found allowable over prior art.

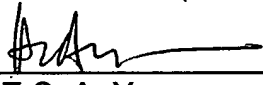
Conclusion

In view of the foregoing, Applicant respectfully submits that claims 1-41 are in condition for allowance. Early issuance of the Notice of Allowance is respectfully requested.

Please charge any shortages and credit any overages to Deposit Account No. 500393.

Respectfully submitted,  
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